

REMARKS*Claim Status*

Claims 1, 3-33 and 35-46 are pending. Claims 1, 3-33 and 35-46 were rejected. It is noted that the examiner also rejected cancelled claims 2 and 34. Rejection with respect to the cancelled
5 claims was improper and should be withdrawn. It is further noted that the finality of the previous Office action was improper inasmuch as the examiner had raised a new ground of rejection with respect to independent claim 23 which was never amended.

Declaration of Prior Invention Overcomes Verba and Cannon

10 With the previous Reply, the inventors diligently prepared and duly submitted evidence and declared under 37 CFR 1.131 that the present invention was conceived and reduced to practice prior to the respective effective filing date of Verba and Cannon. The Declaration was entered per the Request for Continued Examination (RCE) filed on February 25, 2003. However, the Office action dated April 29, 2003 did not acknowledge the Declaration or address the effect
15 thereof. Moreover, the Verba and Cannon patents, which should have been overcome by the Declaration, were again used as secondary references. It is respectfully submitted that, notwithstanding the fact that Verba and Cannon, individually and in combination, do not teach or suggest the invention as discussed in the previous Reply, they are not viable as prior art because the inventors had declared prior invention under 37 CFR 1.131. Therefore, rejections
20 based on Verba and Cannon are submitted to be improper and should be withdrawn.

The Office Action Shall be Complete under 37 CFR 1.104

The previous Reply included arguments, amendments, declaration, and exhibits to the effect that the prior art inventions cited by the examiner do not teach how to obtain nor do they
25 inherently yield one or more advantages, which advantages are urged to warrant issue of a patent on the novel and unobvious subject matter claimed. The examiner did not answer any of the arguments or the asserted advantages.

If it is the examiner's considered opinion that the asserted advantages are without significance
30 in determining patentability of the rejected claims, it is respectfully requested that the examiner states the reasons for his position in the record. By so doing, Applicants will know

that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Patent Appeals and Interferences will also be advised.

The importance of answering such arguments is illustrated by *In re Herrmann*, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable. *See also*, *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed Cir. 1995) (Office failed to rebut applicant's argument).

The Examiner Must Cite the Best References at His Command

37 CFR 1.104 requires that, in rejecting claims for want of novelty or for obviousness, the examiner must cite the best references. *Johnson et al.* (U.S. Pat. No. 6,067,525, hereinafter referred to as "Johnson"), *Verba* (U.S. Pat. No. 6,236,977), and *Cannon* (U.S. Pat. No. 6,286,005), were cited by the examiner in the first Office action (Paper No. 2) over one year ago in which all pending claims were rejected under 35 USC 102(e) as being anticipated by *Verba* and under 35 USC 103(a) as being unpatentable over *Verba* in view of *Cannon*. *Johnson* was not used in the rejection. Thus, it can be inferred that the examiner had considered *Johnson* but did not think *Johnson* was the best reference or the closest prior art in view of the present application as a whole. Subsequently, Applicants amended claims 1 and 33 by incorporating subject matter of dependent claims 2 and 34 and by making the implicit explicit, i.e., explicitly reciting that the intender leads are generated without requiring human intervention or interaction. The amendments are supported by the specification and essentially narrow the scope of claims 1 and 33. Since the Office action did not answer previous arguments regarding *Verba* and *Cannon*, it is not clearly understood why 1) *Johnson* was not used as the best reference in the first Office action; 2) *Johnson* is now the best reference; and 3) *Verba* and *Cannon* are now secondary to *Johnson*. Clarification is respectfully requested.

Johnson Does Not Anticipate the Claimed Invention

Claims 1-9 (claim 2 was previously cancelled), 11, 18, 22, 23-26, 29, 32, 33-41 (claim 34 was previously cancelled), 43, and 46 were rejected under 35 U.S.C. § 102(e) as being anticipated by Johnson. The rejections are respectfully traversed.

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“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Johnson is distinguished from claims 1, 23, and 33 at least because Johnson does not disclose, either expressly or inherently, applying a predictive model to select intender leads from prospects. Johnson teaches predicting the most successful course of action when prior events of interest suggest different, conflicting courses of action. “Predicting the most successful course of action” is fundamentally different from “applying a predictive model to select intender leads from prospects”. That is, predicting “what to do” is not the same as predicting “who they are.” Indeed, as exemplified in the columns cited by the examiner [col. 33, line 60, through col. 34, line 7], the predicted most successful course of action could be “sending out a letter.” To say that “the prediction of the most successful course of action represents the intender lead” is too far a field to make the leap for any one of ordinary skill in the art.

What is more, Johnson does not teach how to identify, mine, or utilize events readily available in a distributed computer system such as the Internet. Johnson teaches an expert system that may be programmed to monitor the sales process for desired (successful) sales events. All of these “events” represent success in the sales process and are generated by interactions between the expert system and the prospect, i.e., a customer purchase of a product, a repeat sale to a customer, a large number of leads being qualified to potential customer, and the like [col. 33, lines 35-41]. In other words, Johnson’s invention is a sales funnel optimization of

prospects that have *proactively* purchased a product or *proactively* expressed interest in doing so. By contrast, the claimed invention operates without the customer's product purchases or his or her proactive expression of interest in a product. That is, the claimed invention generates qualified prospects that are ready to purchase in the near future (i.e., "intender leads") without any interactions between the marketer and the prospects.

Another fundamental difference is that an expert system, such as one disclosed by Johnson, uses explicit rules (if A, then B) extracted through a knowledge engineering step. The inference engine processes these rules (using chaining of the rules) to reach a decision. By contrast, a predictive model relies upon automatically discovered, statistical relationships between input and output variables. Thus, in the predictive model taught and claimed in the present application, there is no concept of a rule, or encapsulation of rules.

In rejecting claim 23, the examiner asserted that Johnson, in col. 35, lines 3-13, describes how customer profile data is correlated throughout the sales cycle (presales phase to sales phase). However, even in pre-sales Johnson's system uses a full complement of lead contact information. There is simply no teaching on how partial information is augmented and matched. Consider the automobile sales ad example discussed in the specification. Suppose a seller places an ad (purchase indicator) on the San Jose Mercury News' website to sell his car. The seller provides, usually buried in the semi-structured text of the ad, a 7-digit phone number without an area code. The present application teaches that, after the seller is identified as a potential future car buyer (prospect), the seller's phone number is extracted, normalized to 10 digits using knowledge of the location of the newspaper website, for example, adding 408 as the area code. The seller's phone number is matched against dealer suppress lists and then reverse appended by matching it against a comprehensive database of US consumer name/postal address/telephone numbers. There is no teaching of any of this in Johnson.

Furthermore, in Johnson, the "without human intervention" feature applies only in limited cases. Johnson describes, in cited col. 4, lines 21-43, a special case where a kiosk gathers lead information (name/address/product interest). Even this special case still requires the prospect to interact with the system, i.e., the marketer's kiosk. If that prospect chooses not to do so,

they are excluded from the lead generation process. By contrast, the claimed invention does not require direct interactions between the marketer and the prospect whatsoever.

Regarding claims 5 and 37, Johnson does not teach that a direct marketing contact is automatically initiated. Cited col. 17, lines 54-58, describe the benefits of Johnson's order management component that tracks order configuration, supplemental orders and changes. This allows a customer to deal directly with a salesperson, who presumably has access to the system, throughout the ordering process. The order management component does not initiate a direct contact with someone who has no knowledge of being selected as an intender lead.

Regarding claims 6, 8, 25, 38, and 40, cited col. 13, lines 7-16 are said to describe how prospect identifiers are populated. Applicants respectfully disagree. Johnson teaches how the customer module (contact manager) can be used by the salesperson to gather customer-specific information that is used throughout the sales system. Johnson does not teach how the prospects and their contact information is automatically identified with no interaction between the prospect and marketer.

Regarding claims 7 and 39, it is respectfully submitted that, in Johnson, reference is made to histories of interaction between the customer and the marketer. Contrastingly, the claimed invention profiles prospects even if they have had no previous contact or interaction with the marketer.

Regarding claims 9, 26, and 41, it is respectfully submitted that "data enhancement" as taught and claimed in the present application differs markedly from Johnson's "editing". "Data enhancement" refers to appending data elements such as psychographic or demographic attributes (such as age, gender, household income or marital status) from a third party database to a customer or prospect record. The present application provides teaching as to how data enhancement is performed when only limited contact information such as a phone number without area code is available. Unlike Johnson, the claimed invention contemplates data enhancement, in conjunction with a predictive model, to identify the best prospects without requiring any direct interaction with them. By contrast, Johnson's "editing" refers to the

process of customizing templates in presentations and proposals to prospects already well down the sales lead ‘funnel’. The editing decisions are made using, in part, information collected *from* the customer. Even the “other information which the salesperson imports into the sales system” doesn’t contemplate data enhancement. This is supported by the fact that, despite hundreds of fields listed in Fig. 15 A-C of Johnson, no demographic or psychographic attributes are listed. There is simply no teaching on “data enhancement” in Johnson.

Regarding claims 11, 28, 29, and 43, Johnson’s Product Configuration Information does not specify the source of this data as classified advertising. Furthermore, there is no teaching on how classified advertising data could be automatically identified outside the expert system, parsed, mined and linked back to the customer/prospect record. Indeed, product information in this context likely refers to a customer’s stated buying preferences based on direct interaction with the sales person.

Regarding claims 22, 32, and 46, Johnson describes, in cited col. 11, lines 48-57, a conventional Internet lead generation capability in which the site interactively prompts the customer/prospect for information. The prospective customer may also select a product or service of interest. To reiterate, this is not how the claimed invention works. The claimed invention does not contemplate a direct interaction between the prospect and marketer to identify intender leads. The Internet is utilized as a vehicle for accessing large amounts of semi-structured text (not resulting from the interactions between the marketer and the prospect). The mined data is then enhanced to identify intenders and leads generated thereof are delivered to the marketer directly. The prospect does not even know they have been identified as an intender.

Johnson Does Not Suggest the Claimed Invention

Claim 18 was rejected under 35 USC 103(a) as being unpatentable over Johnson and in view of Verba. Claims 10, 27, and 42 were rejected under 35 USC 103(a) as being unpatentable over Johnson in view of Cannon. As discussed before, Verba and Cannon are not viable prior art references because Applicants had declared prior invention under 37 CFR 1.131. Nevertheless, it is respectfully submitted that the combinations of Johnson in view of Verba and Johnson in

view of Cannon do not teach or suggest the claimed invention for the same reasons discussed heretofore with respect to Johnson and in the previous Reply with respect to Verba and Cannon, which the examiner did not argue to the contrary.

5 Claims 12-14, 30, 31, 44, and 45 were rejected under 35 USC 103(a) as being unpatentable over Johnson. Specifically, the examiner alleged that Johnson incorporates electronic advertising in order to generate leads [col. 4, lines 21-27]. 'Electronic advertising' for lead generation is not well defined in Johnson. However, based on the more detailed description of website and kiosks [col. 4, lines 29-33, col. 11, lines 38-63], it can be inferred, and one skilled
10 in the art would have readily recognized, that the lead generation in Johnson is a direct result of interactions between the prospect and the marketer. This is supported by the fact that Johnson specifically teaches that the lead generation component operates to recognize events occurring in the fully integrated expert system [*id.*] and not in a distributed computer system such as the Internet. Another distinction is that Johnson's electronic advertising is a tool for
15 lead generation, in which the marketer places the ads to initiate an explicit dialogue with the prospect. On the contrary, the claimed invention extracts information from the classified ad to identify the consumer who places the ads to, for example, sell an item, not buy one. The information gathered by an automated spider (webcrawler) is used transparent to the consumer who has no interactions with the marketer until he or she is identified as an intender.

20 Regarding claims 15, 16, 19-21, Official notice is taken that it is old and well known in the art for a purchase indicator to comprise resumes, engagement/wedding announcements, birth announcements and obituaries. Applicants respectfully traverse the Official notice based on evidence previously submitted with the aforementioned Declaration.

25 Historically, it is difficult to generate intender leads in a timely manner. One skilled in the art would have known that timeliness is of critical importance to marketers. For example, death records processed by governmental agencies (sources) are usually not available for 30-60 days. With the claimed invention, information contained in online obituaries can be advantageously
30 harvested and applied immediately. This is a critical time difference for marketers.

Moreover, one skilled in the art would have readily recognized that there was no assurance that listing a car for sale was a leading indicator of “intent to purchase a vehicle”. As discussed in detail in the previous Reply and submitted in the Declaration, Applicants diligently conducted a pilot test to validate and ensure that seemingly trivial classified ads do contain purchase indicators that could be mined to provide quality intender leads. These certainly are not obvious extensions of “old and well known” purchase indicators, as alleged by the examiner. If it were obvious to one of ordinary skill in the art, why would the industry’s leading marketing data supplier to the automotive industry sign a multi-year, valued at nearly \$1 million contract to buy intender leads generated by the claimed invention? Applicants respectfully request that the examiner considers the commercial success of the claimed invention as presented in the evidence previously submitted with the Declaration. Applicants further respectfully request that the examiner provides an affidavit to support the Official notice. “When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. [MPEP 2144.03].

The examiner also alleged that “it would have been obvious to one of ordinary skill in the art for the purchase indicator to comprise resumes, engagement/wedding announcements, birth announcements and obituaries with the motivation of demonstrating the ability to present the purchaser with items of everyday interest, thereby encouraging prospect leads to come forward and make purchase.” The instant invention does not present the purchase with items of everyday interest, nor does it encourage prospect leads to come forward and make purchase. As taught and claimed in the present application, the quality intender leads are generated without disturbing the entire pool of prospective customers and are delivered directly to interested parties such as marketers. The examiner’s statement does not seem to apply to “generating intender leads from prospects in accordance with a predictive model without requiring human intervention or interaction,” as claimed in the present application. Applicants respectfully request that the examiner clarifies his statement. Alternatively, if the examiner is having difficulty understanding the claimed invention, the examiner is sincerely invited to telephone the undersigned for clarification.

Claim 17 was rejected under 35 USC 103(a) as being unpatentable over Johnson and in view of Lazarus, although Verba's patent number was recited for both references. Specifically, the examiner states,

5 "Johnson et al fails to disclose ... wherein said postings comprise requests for purchase recommendations...(Col. 5, lines 18-27). It would have been obvious to one of ordinary skill in the art to post requests for purchase recommendations..."

Again, the examiner seemed to have misunderstood the claimed invention. The instant invention does not post requests for purchase recommendations. Rather, it mines useful
10 information contained in the postings, which, in the case of claim 17, include requests for purchase recommendations. On the other hand, in Johnson, all system modules are integrated to provide assistance to sales personnel making the maximum amount of information regarding the potential product or service [*id.*]. Even if it were obvious to one of ordinary skill in the art to post requests for purchase recommendations in public places
15 such as newsgroups, discussion forums, and email lists, Johnson lacks any teachings to enable the integration of public postings into the expert system so to extract information contained therein to identify prospects. On the contrary, the claimed invention transparently monitors postings/discussions taking place in public open forums such as e-mail lists, newsgroups, and/or chat rooms and mines information contained therein to
20 generate intender leads without disturbing the entire pool of prospects. This is one of the many advantages specifically argued in the previous Reply.

Conclusion

For the foregoing reasons, it is respectfully submitted that independent claims 1, 23, and 33
25 recite subject matter not reached by the applicable prior art under 35 USC §§ 102(e) and 103(a) and therefore should be allowed. Reliance is placed on *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) and *Ex parte Kochan*, 131 USPQ 204 (Bd. App. 1960) for the allowance of dependent claims 3-22, 24-32, and 35-46, since they differ in scope from their respective parent independent claims 1, 23, and 33, which are submitted as patentable. Since
30 the examiner has done a thorough search in the previous actions in light of the entire application disclosure including drawings and claims, no new search should be necessary.

Accordingly, Applicants respectfully submit that the present application is in a condition for allowance. Favorable consideration and a Notice of Allowance of all pending claims are therefore earnestly solicited. The examiner is invited to telephone the undersigned at (650) 424-0100 extension 8413 for discussing an Examiner's Amendment or any suggested actions
5 that would accelerate prosecution and forward the present application to allowance.

Respectfully submitted,



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